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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,162	09/28/2001	John C. Goodwin III	9959.00	4085

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EXAMINER
WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _28 September 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-23 have been examined.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Also, a claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *See AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2dat 1452.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 3, 12 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

5.   Claim 3 recites the limitation "the substep" in line 2. There is insufficient antecedent

basis for this limitation in the claim.

6.   Claim 12 recites the limitation "first customer selections" in line 10. There is insufficient

antecedent basis for this limitation in the claim.

7.   Claim 22 recites the limitation "second customer selections" in line 14. There is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 1, 2, 4-11, 7-11 and 17- 21 are rejected under 35 U.S.C. 102(e) as being

anticipated by US Publication No. 2002/0055911 to Guerreri.

        Guerreri discloses recording customer selections of the value card configuration options

(see paragraph [0029], lines 1-9) and sending the selections to a value card host for later retrieval

during a transaction in which the value card is used for payment (see paragraphs [0025] and

[0030]). Guerreri does not explicitly teach displaying value card configuration option; however,

this is an inherent step. That is, before recording customer selections, the customer must first be

presented with the information; thus, the "information intended for the computer user" is

displayed (see paragraph [0018]).

Referring to claims 2 and 8, Guerreri discloses recording payment from a customer (see

paragraph [0031]).

Referring to claim 4, Guerreri discloses the substep of sending the selections over the

Internet to a computer at the value card host (see paragraph [0017]). It is known in the art that

TCP/IP is the de facto standard for data transmission over the Internet.

Referring to claims 5 and 11, Guerreri discloses the substep of sending the selections

over a phone connection (i.e. "other similar computer communication devices") to a computer at

the value card host (see paragraph [0017]).

Referring to claims 6 and 10, Guerreri discloses the substep of sending the selections

over a network connection to a computer at the value card host (see paragraph [0017]).

Referring to claim 7, Guerreri discloses recording customer selections of the value card

configuration options (see paragraph [0029], lines 1-9), assigning a value card identification

number (i.e. "account number printed on the card") to the value card (see claim 21), dispensing

value card (see claim 2) and sending the selections and the value card identification number to a

value card host for later retrieval during a transaction in which the value card is used for payment

(see paragraphs [0025] and [0030]). Note. When the customer logs into the clearinghouse

server computer/host the customers prepaid card/account information is sent to the server, the

examiner notes that the prepaid card/account information includes the card identification

number. Guerreri does not explicitly teach displaying value card configuration option; however,

this is an inherent step. That is, before recording customer selections, the customer must first be

presented with the information; thus, the "information intended for the computer user" is

displayed (see paragraph [0018]).

Referring to claim 9, Guerreri discloses determining a value card password, and sending

the value card password to the value card host (see paragraph [0030]).

Referring to claim 17, Guerreri discloses a display for displaying value card

configuration options, (i.e. "information intended for the computer user") (see paragraph [0018]),

an input (i.e. "clearinghouse server computer") for recording customer selections of the value

card configuration options (see paragraph [0029], lines 1-9) and a computer (i.e. "client

computer") for controlling the display and the input and for sending the selections to a value card

host for later retrieval during a transaction in which the value card is used for payment (see

paragraphs [0025] and [0030]).

Referring to claim 18, Guerreri discloses means for recording payment from a customer

(i.e. "clearinghouse server computer") (see paragraph [0031]).

Referring to claim 19, Guerreri discloses a connection to another computer at the value

card host (see paragraph [0017]).

Referring to claim 20, Guerreri discloses a display for displaying value card

configuration options, (i.e. "information intended for the computer user") (see paragraph [0018]),

an input (i.e. "clearinghouse server computer") for recording customer selections of the value

card configuration options (see paragraph [0029], lines 1-9) and a computer for controlling the

display and the input, for assigning a value card identification number to the value card (i.e.

"account number printed on the card") to the value card (see claim 21), for dispensing the value

card (see claim 2), for establishing connection to a value card host computer and for sending the

selections to a value card host for later retrieval during a transaction in which the value card is

used for payment (see paragraphs [0025] and [0030]).

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

11.   Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guerreri

as applied to claims 1 and 20 respectively above, and further in view of US Publication No.

2001/0013551 to Ramachandran.

Guerreri discloses a processor displaying "information intended for the computer user"

(see paragraph [0018]). Guerreri does not expressly disclose a substep of displaying first value

card configuration options within a group of second value card configuration options including

total monetary value, payment amount limit at each transaction, individual goods and services,

individual goods and services providers, and services, individual goods and services providers,

categories of goods and services, categories of goods and services providers, and purchase times

and dates. Ramachandran discloses a substep of displaying first value card configuration options

within a group of second value card configuration options including total monetary value,

payment amount limit at each transaction (see figs. 62 and 63; paragraph [0125]). As for the

substep displaying first value card configuration options within a group of second value

configuration options including individual goods and services, individual goods and services

providers, categories of goods and services providers, categories of goods and services,

categories of goods and services providers, and purchase times and date these are nonfunctional

descriptive material and are not functionally involved in the step recited. The displaying step

will be performed the same regardless of the data. Thus, this descriptive material will not

distinguish the claimed invention form the prior art in terms of patentability, see In re Gulack,

703F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32F.3d 1579, 32

USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary

skill in the art the time the invention was made to display any type of configuration options

because such data does not functionally relate to the steps in the method claimed and because the

subjective interpretation of the data does to patentably distinguish the claimed invention.

12.   Claims 12 –16, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Guerreri in view of US Publication No. 2003/0053609 to Risafi et al.

        Guerreri discloses sending the value card identification information to a value card host

(paragraph [0030]). Note. When the customer logs into the clearinghouse server computer/host

the customers prepaid card/account information is sent to the server, the examiner notes that the

prepaid card/account information includes the card identification number. Guerreri also

discloses recording customer selections of the value card configuration options (see paragraph

[0029], lines 1-9) and sending the selections to a value card host for later retrieval during a

transaction in which the value card is used for payment (see paragraphs [0025] and [0030]).

Guerreri does not explicitly teach displaying value card configuration options including first customer selections from the value card configuration information; however, this is an inherent step. That is, before recording customer selections, the customer must first be presented with the information; thus, the "information intended for the computer user" is displayed (see paragraph [0018]). Guerreri does not expressly disclose reading value card identification information from the value card or obtaining value card configuration from the value card host. Risafi et al. disclose reading value card identification information from the value card, sending the value card identification information to a value host and obtaining value card configuration from the value card host (see paragraph [0015], lines 16-26). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Guerreri to include the step of reading value card identification information. One of ordinary skill in the art would have been motivated to do this because reads information that has been magnetically encoded.

Referring to claim 13, Guerreri discloses recording payment from a customer (see paragraph [0031]).

Referring to claim 14, Guerreri discloses determining a value card password from the value card configuration information and recording successful customer entry of the value card password prior to completing steps (d) through (f) (see paragraph [0030]).

Referring to claim 15, Guerreri discloses the substep of sending the selections over a phone connection (i.e. "other similar computer communication devices") to a computer at the value card host (see paragraph [0017]).

Referring to claim 16, Guerreri discloses the substep of sending the selections over a network connection to a computer at the value card host (see paragraph [0017]).

Referring to claim 22, Guerreri discloses a display for displaying value card configuration options, (i.e. "information intended for the computer user") (see paragraph [0018]), an input (i.e. "clearinghouse server computer") for recording customer selections of the value card configuration options (see paragraph [0029], lines 1-9) and a computer for controlling the display and the input device, for establishing connection to a value card host computer and for sending the selections to a value card identification information to the value card host computer via the connection, for obtaining value card configuration information form the value card host computer, for sending the second customer selections to the value card host computer for later retrieval during a transaction in which the value card is used for payment (see paragraphs [0025] and [0030]). Guerreri does not expressly disclose a card reader. Risafi et al. disclose a card reader for reading value card identification information from the value card (see paragraphs [0109] and [0015], lines 16-26). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclose by Guerreri to include a card reader. One of ordinary skill in the art would have been motivated to do this because it provides a means for reading magnetically encoded information.

Referring to claim 22, Guerreri discloses the computer also determines a value card password from the value card configuration information, and records successful customer entry of the value card password prior to the display of the first customer selections and the recording of the second customer selections (see paragraph [0030]).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306, 703-746-9443 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 18, 2004